

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-7, drawn to a processing solution;

Group II: Claims 8-10, drawn to a conversion film; and

Group III: Claims 11-26, drawn to a method for forming a conversion film.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the relationship between Groups I and III as related as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product as claimed can be used as “a processing solution for an article other than zinc alloy plating.” However, the Office has failed to suggest or identify what “other than zinc alloy plating” *is*, and therefore the Office’s allegation effectively reduces to a suggestion that the claimed “processing solution” could be used for some other unidentified purpose. Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the restriction requirement, because the “burden is on the examiner to provide an example”. By failing to identify what “other than zinc alloy plating” includes, the Office has failed to provide “an example”, as required. Furthermore, the proposed alternative process must be shown to be “materially different” from the claimed process (MPEP §806.05(h)). Since “other than zinc alloy plating” has not been defined, the Office has also failed to show that “other than zinc alloy plating” is materially different from the claimed process. Withdrawal of the restriction requirement is respectfully requested.

The Office has characterized the inventions of Groups II and III as related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the product as claimed can be made by a “materially different process” with “an alternative solution” or “by sputtering”. However, there is no evidence of record to show that the claimed product can be made by these alternative processes as the Office has alleged. If in fact the claimed product can be made by one of these alternative processes, Applicants respectfully submit that the Office has not shown how they are materially different from the claimed process. Accordingly, Applicants respectfully request withdrawal of the restriction requirement.

The Office has characterized the inventions of Groups I and II as “unrelated.” However, Applicants note that the MPEP describes unrelated inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing”, or “a process of painting a house and a process of boring a well.” MPEP § 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement with regard to the patentable distinctness of the inventions of Groups I and II, but respectfully submit that the Office has not shown how the inventions of these groups meet the standard of “unrelatedness” of MPEP § 806.04(A). Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Withdrawal of the requirement for restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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